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4-19-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art. Unit : 1615
Examiner : Amy E. Pulliam
Serial No. : 09/648,304
Filed : August 25, 2000
Inventors : Airton Monza da Silveria
 Gilles Ponchel
 Dominique Duchene
 Patrick Couvreur
 Francis Puisieux
Title : NANOPARTICLES COMPRISING Confirmation No.: 6411
 AT LEAST ONE POLYMER AND
 AT LEAST ONE COMPOUND
 ABLE TO COMPLEX ONE OR
 MORE ACTIVE INGREDIENTS



22469

PATENT TRADEMARK OFFICE

Docket No.: 1369-00

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Dated: April 19, 2002

RESPONSE

Commissioner of Patents
Washington, D.C. 20231

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Sir:

This Response is submitted in response to the Advisory Action dated March 21, 2002 and further in response to the Official Action dated November 20, 2001, and in conjunction with a Request for Continued Examination. This Response assumes entry of the Amendment filed under date of February 20, 2002, which entry is requested in the RCE Transmittal sheet.

This Response addresses not only issues raised in the November 20, 2001 Final Rejection, but the Advisory Action dated March 21, 2002.

The Advisory Action indicated that the Amendment filed under date of February 20, 2002 would not be entered into the Official File inasmuch as the "new limitation would require further search and/or consideration as it significantly changes the scope of many of the claims" when referring to the Applicants' Amendment to replace "compound able to complex the active ingredient" with "cyclic oligosaccharide." We respectfully submit that such a position is clearly in error, inasmuch as the amendment to independent Claim

1, which contained the above-referenced change, was merely an incorporation of already claimed subject matter from dependent Claim 3 into Claim 1. Surely, such an incorporation of subject matter from a pre-existing claim into an independent claim would require no further search and no further consideration since Claim 3, by definition, had already been searched and considered.

The refusal to enter the Amendment was coupled with the further statement that the “position asserted in the final Office Action” was maintained. This position is contrary to fundamental concepts of applying prior art publications against claims and forming rejections. Specifically, Claims 1, 2, 6 - 8, 12, 13, 21 and 22 were rejected in the final Office Action under 35 U.S.C. §102(e) as anticipated by Ramtoola. Inasmuch as the amendment added the subject matter of Claim 3 to independent Claim 1 and inasmuch as Claim 3 was not rejected under 35 U.S.C. §102 as being anticipated by Ramtoola, it is contrary to PTO practice to continue to reject Claims 1, 2, 6- 8, 12, 13, 21 and 22 for the same reasons.

In effect, the Advisory Action creates a retroactive rejection of Claim 3 under §102 which the Applicants never had a chance to address. We accordingly respectfully submit that the final rejection did not contain a rejection of Claim 3 (now combined into Claim 1) under §102 based on Ramtoola. We respectfully submit that maintaining the rejection of Claim 1 on the same grounds is in error and respectfully request prompt withdrawal of that rejection.

Further, Claim 1 as now recited specifically calls for at least one cyclic oligosaccharide. Careful scrutiny of the entire Ramtoola disclosure reveals that not a single word is set forth in Ramtoola concerning cyclic oligosaccharides. We accordingly respectfully submit that, in the absence of an either explicit or implicit disclosure of all aspects of Claim 1, Ramtoola is inapplicable to Claims 1, 2, 6 - 8, 12, 13, 21 and 22 from

the previous rejection. Withdrawal of the §102 rejection based on Ramtoola is accordingly respectfully requested.

Claims 1, 2 and 6 - 23 were rejected under §103 as being obvious over Ramtoola. Again, we respectfully submit that the Advisory Action essentially applies a retroactive rejection of Claim 3 (now combined into Claim 1) and is, accordingly, improper under Patent Office Rules. Withdrawal of the 35 U.S.C. §103 rejection of Claims 1, 2 and 6 - 23, based on Ramtoola, is accordingly respectfully requested.

Those claims are further patentable over Ramtoola for essentially the same reasons set forth above, namely the total failure of Ramtoola to disclose, teach or even remotely suggest cyclic oligosaccharides as recited in Claim 1. In fact, we respectfully submit that the failure of Ramtoola to even remotely suggest cyclic oligosaccharides or any compound similar thereto, renders it non-enabling as a possible basis upon which a §103 rejection can be based. We accordingly respectfully request withdrawal of the §103 rejection of Claims 1, 2 and 6 - 23 over Ramtoola.

We acknowledge the continued rejection of Claims 1 - 5 under 35 U.S.C. §103 as being obvious over the combination of Chen with Trinh. This rejection was contained in the final rejection and is not subject to the comments set forth above with respect to the rejections based on Ramtoola. In any event, however, Claims 1 - 5 are patentable over the hypothetical combination of Trinh with Chen by the reasons set forth in the prior Amendment.

Moreover, we respectfully submit that, even if one of ordinary skill in the art were to substitute the cyclodextrin of Trinh for the complexing agents of Chen, the resulting controlled release preparation would be microspheres containing the cyclodextrin complexing agent, among other things. Unfortunately, this is not what the Applicants claim. Reference to Claims 1 - 5 shows that the claims refer to nanoparticles, not

microspheres. Accordingly, on this basis alone, the hypothetical combination of Trinh with Chen must fall. There are simply no teachings or suggestions in Chen that, even with the cyclodextrin substituted for the metal ion complexing agent, such complexing agent would result in nanoparticles. The clear teachings of Chen produce microspheres having a size range of 10 - 200 μm . Clearly, microspheres of a size of 10 - 200 μm are not nanoparticles. We accordingly respectfully submit that, in the situation where teachings from a secondary reference are combined with the teachings of a primary reference and the resulting product still does not teach or suggest the invention as claimed, that a rejection for obviousness cannot stand. We accordingly respectfully request withdrawal of the 35 U.S.C. §103 rejection of Claims 1 - 5, based on the hypothetical combination of Trinh with Chen.

By way of summary, the final rejection rejected Claims 1, 2, 6 - 8, 12, 13, 21 and 22 as being anticipated by Ramtoola. The Applicants combined the subject matter of Claim 3 into Claim 1, thereby rendering the anticipation rejection moot. The final rejection rejected Claims 1, 2 and 6 - 23 as being obvious over Ramtoola. The Applicants combined the subject matter of Claim 3 with Claim 1, thereby rendering the obviousness rejection based on Ramtoola moot. This leaves Claims 6 - 23 as being completely free of the prior art and immediately allowable. Claims 1 - 5 were rejected in the final rejection as being obvious over a hypothetical combination of Trinh with Chen. We respectfully submit that Claims 1 - 5 are also allowable inasmuch as, even if one of ordinary skill in the art substitutes the cyclodextrin complexing agent of Trinh for that taught by Chen, the resulting product will still not be the same as that claimed in Claims 1 - 5 and would further not be suggestive thereof.

In light of the forgoing, we respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,


T. Daniel Christenbury
Reg. No. 31,750
Attorney for Applicants

TDC:lh
(215) 563-1810